

ASK THE TIC

PROTECTING INTELLECTUAL PROPERTY RIGHTS ABROAD: RESOURCES FOR U.S. EXPORTERS

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Globalization and the rapid proliferation of technology have elevated the importance of intellectual property protection for small and medium-sized enterprises (SMEs). The intangible nature of intellectual property and the worldwide inconsistency of practices create challenges for U.S. businesses wishing to protect their ideas, brands, and business methods in foreign markets. The three most common vehicles for protecting intellectual property are patents, trademarks, and copyrights. This article provides exporters with an overview of intellectual property rights and the methods used to protect these rights internationally.



WHAT IS INTELLECTUAL PROPERTY?

The World Intellectual Property Organization (WIPO) defines intellectual property (IP) as “creations of the mind: inventions, literary and artistic works, and symbols, names, images, and designs used in commerce.” More specifically, IP refers to a broad collection of rights relating to such matters as works of authorship, which are protected under copyright law; inventions, which are protected under patent law; marks, which are protected by trademark law; as well as trade secrets, designs, and other related rights. It is important to note that these forms of intellectual property are very different and the protection afforded under them serves different purposes. To learn more about Intellectual Property Rights (IPR), visit the WIPO Web site: www.wipo.org.



WHAT ARE INTELLECTUAL PROPERTY RIGHTS?

Intellectual property rights give the owners of ideas, inventions, and creative expression the right to exclude others from access to or use of their property for a certain period of time. No international treaty completely defines these types of IP, and the laws of the various countries differ significantly in terms of the degree of protection and enforcement available under

national law. The United States provides a wide range of protection for IP through the registration of patents, trademarks, service marks, copyrights, and trade secrets. However, the rights granted extend only throughout the United States, its territories and possessions. They confer little or no protection in other countries. To secure full rights in another country, you must apply for a patent or register a trademark or copyright in that country. Nevertheless, some advantages and minimum standards for the protection and enforcement of IP exist under treaties or other international agreements. To learn about the specific intellectual property laws and requirements of individual countries, visit the WIPO Guide to Intellectual Property Worldwide: www.wipo.int/about-ip/en.

The question of whether to pursue international protection for IP is not always clear-cut. For example, there may be cases in which it is advisable to forego patent protection to safeguard trade secrets and sensitive information that may need to be published in the patent process. In any case, the first step in determining if IP protection is right for your company is to secure the services of specialized legal counsel. It is important to note that in addition to obtaining patent protection, you should also protect your trade secrets through appropriate confidentiality provisions in employment, licensing, marketing, financing, distribution, and joint venture agreements.



HOW ARE INTELLECTUAL PROPERTY RIGHTS ENFORCED ABROAD?

The ease of IPR enforcement depends on local law, the resources of the intellectual property owner, the attitude of local officials, and many other factors. In the United States and many other countries, intellectual property owners pursue infringement claims through civil litigation. Internationally, avenues to address IP infringement vary by country and local law. It is important to seek proper legal advice on any issues related to IPR enforcement. For more information on enforcement and dispute resolution, visit the WIPO SME Web site, www.wipo.int/sme/en and click on IP for Business.



HOW DO I OBTAIN PATENT, TRADE-MARK, OR COPYRIGHT PROTECTION IN ANOTHER COUNTRY?

PATENTS: A patent is a legal instrument that gives its owner certain exclusive rights for an invention. Most

patents are directed to a product or process that provides a new or improved way of doing something, or offers a new technical solution to a problem. The life span of a patent depends on many factors, but once secured, a patent generally provides protection to its owner for a period of 20 years from the filing date of the patent application. Since a patent granted by the U.S. Patent and Trademark Office (USPTO) only protects the owner of the patent in the United States, it may be necessary to obtain patent protection from foreign patent offices for any commercial activity to be conducted outside the United States.

The Patent Cooperation Treaty (PCT) streamlines the process for U.S. inventors and businesses wishing to obtain patent protection in other countries. By filing one international patent application with the USPTO, U.S. applicants can concurrently seek protection in up to 115 countries. For an invention made in the United States, U.S. law prohibits filing abroad without a foreign filing license from the USPTO, unless six months have elapsed since filing a U.S. application. For more on the benefits of filing for an international patent under the PCT, see the January 2002 *Export America* article, "The Advantages of Using the Patent Cooperation Treaty."

For more information on filing for a patent in the United States, visit the USPTO Web site at www.uspto.gov or call the Patent Assistance Center at (800) 786-9199 or (703) 308-4357. One may also file for a U.S. patent electronically using the USPTO's Electronic Filing System: www.uspto.gov/ebs/efs/index.html. For filing an international patent under the PCT, visit the USPTO Web site: www.uspto.gov/go/pct. Additional information on the PCT is also available on the WIPO Web site: www.wipo.org/pct/en/index.html

TRADEMARKS: A trademark is a word, name, symbol, or device that identifies and distinguishes the source of goods used in trade. In short, a trademark is a brand name. Service marks perform the same function for businesses dealing in services rather than goods.

In the United States, rights to trademarks, service marks, and other marks are acquired through use or prior foreign registration. However, in most countries, trademark rights are acquired only through registration, and many countries require local use of the registered mark to maintain the registration. Whether a given mark can be registered in a particular country depends on the law of that country. For example, some countries do not protect service marks. The United States is not a member of any agreement under which a single filing will provide international protection.

Protecting trademarks in foreign markets was the subject of an earlier *Export America* article, "A Small Business Primer to Filing for Trademarks in a Foreign Country," published in March 2001.

To learn more about trademarks, visit the USPTO Web site: www.uspto.gov or call the Trademark Assistance Center at (800) 786-9199 or (703) 308-9000. One can also file a trademark application electronically using the USPTO Trademark Electronic Application System (TEAS): www.uspto.gov/teas/index.html.

COPYRIGHTS: A copyright protects original works of authorship. In the United States, this protection gives the owner the exclusive right to reproduce, prepare derivative works, distribute copies, or perform or display the work publicly.

No "international copyright" provides universal protection for your work throughout the world. However, securing copyright protection has been greatly simplified under international copyright treaties and conventions, such as the Berne and Universal Copyright Conventions. In most countries, including the United States, registration is typically not required. Some countries, however, offer little or no protection for the works of foreign nationals. Ultimately, copyright protection depends on national law. Before publishing a work anywhere, it is advisable to investigate the scope of protection available, as well as the specific legal requirements for copyright protection in countries in which protection is desired.

To learn more about copyrights, visit the U.S. Copyright Office Web site at www.copyright.gov or call (202) 707-3000 to speak with a copyright information specialist. Certain users can also register a copyright electronically using the U.S. Copyright Office CORDS Electronic Registration System: www.loc.gov/copyright/cords. ■

FOR MORE INFORMATION

The Trade Information Center (TIC) is operated by the International Trade Administration of the U.S. Department of Commerce for the 19 federal agencies comprising the Trade Promotion Coordinating Committee. These agencies are responsible for managing the U.S. Government's export promotion programs and activities. You, too, can "Ask the TIC" by calling 1-800-USA-TRAD(E) toll free, Monday through Friday, 8:30-5:30 EST. Or visit the TIC's Web site at www.export.gov/tic.